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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,686	10/16/2001	Joseph R. Nardone	003636.0125	3773
<div>7590 01/17/2008</div> <div>William H. Bollman Manelli Denison & Selter PLLC 2000 M Street, N.W. Suite 700 Washington, DC 20036</div> <div>EXAMINER CHANKONG, DOHM</div> <div>ART UNIT 2152</div> <div>PAPER NUMBER</div> <div>MAIL DATE 01/17/2008</div> <div>DELIVERY MODE PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/977,686

Applicant(s)

NARDONE ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1> This action is in response to Applicant's request for continued examination. Claims 1, 15, 20, 21, 26, and 27 are amended. Claims 1-31 are presented for further examination.
- 2> This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

- 3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10.24.2007 has been entered.

Response to Arguments

- 4> Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Allowable Subject Matter

- 5> Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 8 would be allowable if rewritten to overcome the

rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: examiner notes that the previous examiner had rejected claim 8 under Alam, citing column 10, lines 36-43. In general, full faith and credit is given to the previous examiner's search and action unless there is clear error. MPEP §704.01.

The action, filed on 12.6.2006 by the previous examiner, contained a clear error in rejecting claim 8 relying solely on Alam. While Alam does disclose the well known features of a method call and it is well known that that such method calls contains parameters (see rejection of claim 5), Alam does not expressly or implicitly disclose the features of claim 8. Specifically, there is no teaching of a parameter that identifies a different application to perform a next instruction after executing the synchronization instruction.

Additionally, such a feature had not been taught in the art in relation to synchronizing a PDA with a host device. Thus, the previous rejection of claim 8 is withdrawn and is objected to as indicated in this section.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6> Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Applicant has amended the independent claims to recite a synchronization instruction that comprises two commands, the first used for synchronizing information and the second for passing control to a particular application after synchronization. This amendment is unsupported by Applicant's specification.

Specifically, Applicant's specification actually equates the instruction to a command [pg. 7, line 20 : "the actual command or instruction"] and that a single command is issued [pg. 8, lines 5-9]. There is no disclosure that the synchronization instruction actually comprises two commands, where one of the commands passes control to a particular application after synchronization.

Rather, Applicant's specification and dependent claims 5-8 describe that the instruction contains parameters, and the parameters specified within the instruction actually are responsible for determining whether control of the processing is passed to another application. Claim 8 in particular seems to reflect the functionality intended to be captured by Applicant's amendment to the independent claims.

The functionality - passing control of processing to another application after synchronization is completed through the use of a parameter within the synchronization instruction - describes allowable subject matter. As indicated above, claim 8 is objected to as being allowable if it were rewritten in independent form including all limitations of the base claim and any intervening claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7> Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Independent claims 1, 15, 20, 21, 26, and 27 are amended to recite "a command to pass control to a particular application." It is unclear as to the control of claim element is being passed to the particular application. The claims should be amended to clarify which control element's control is being passed.

b. The dependent claims are rejected based on their dependency on the deficient independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8> Claims 1-7 and 9-31 are rejected under 35 U.S.C §103(a) as being unpatentable over Alam et al, U.S Patent No. 6,324,544 ["Alam"], in view of Hawkins et al, U.S Patent No. 5,884,323 ["Hawkins"].

9> Alam disclosed a method for synchronizing file objects in object stores between a mobile device and a host computer. In an analogous art, Hawkins disclosed a method for synchronization process negotiation between a handheld computer systems and a host computer on which data are to be synchronized.

10> Concerning claims 1, 15, 20, 21, 26, and 27, Alam did not explicitly state that the synchronization instruction comprises a command that passes control to a particular application after synchronization. Although Alam refers to synchronizing objects upon connection of the devices, he is not specific on this aspect and so is not explicit about the commands within the synchronization instruction.

However, Hawkins discloses this feature as his system contains a command that passes control to particular a particular application after synchronization is complete [column 8 «lines 11-15»]. Specifically, Hawkin's SyncUnRegister() command ends the synchronization and passes control the sync manager library. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Alam by adding the ability to specify when control of the processing should be passed to a different application when synchronization is complete as taught by Hawkins. Here the

combination satisfies the need for efficiently ending the synchronization while specifying which application should continue running on the PDA.

11> Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as an apparatus are rejected under the same rationale applied to the described claim.

12> Thereby, the combination of Alam and Hawkins discloses:

- <Claim 1>

A method of reconciling data between a host device wirelessly connected to a personal data assistant, comprising:

commencing execution of an application on said personal data assistant (Alam, column 10, lines 44-52);

executing a synchronization instruction from said application (Alam, Figure 1 | column 10, lines 53-62 and column 12, lines 15-63 where the manager application runs on the personal data assistant and executes methods to perform synchronization), said synchronization instruction comprising a command for synchronizing information between said personal data assistant [Alam, column 10 «lines 25-43»] and a command to pass control to a particular application after synchronization [Hawkins, column 8 «lines 11-15»]; and

synchronizing data over a wireless connection stored in said personal data assistant with data stored in said host device (Alam, column 13, lines 6-17 and column 5, lines 36-52).

- <Claim 2>

The method of claim 1, further comprising: establishing a TCP/IP communication link between said host device and said personal data assistant for synchronizing said data (Alam, column 5, lines 35-52).

- <Claim 3>

The method of claim 1, further comprising: launching a first synchronization process on said personal data assistant in response to said executing a synchronization instruction (Alam, figure 6, item 140); and launching a second synchronization process on said host device in response to said executing a synchronization instruction (Alam, figure 6, item 148).

- <Claim 4>

The method of claim 3, wherein: said synchronizing is performed by said first synchronization process and said second synchronization process (Alam, column 13, lines 38-49).

- <Claim 5>

The method of claim 4, wherein: said executing a synchronization instruction further comprises executing from the application a synchronization instruction having at least one parameter (Alam, column 10, lines 9-23).

- <Claim 6>

The method of claim 5, wherein: said at least one parameter identifies data for synchronization (Alam, column 11, lines 44-61).

- <Claim 7>

The method of claim 6, wherein: said identified data includes data stored in at least one database in said personal data assistant that is synchronized with data stored in an associated database in said host device (Alam, column 10, lines 53-62).

- <Claim 9>

The method of claim 5, wherein said step of executing a synchronization instruction further comprises: extracting said at least one parameter from said synchronization instruction; and storing said at least one parameter in memory in said personal data assistant (Alam, column 12, lines 48-67).

- <Claim 10>

The method of claim 9, wherein said executing a synchronization instruction further comprises: retrieving said stored at least one parameter from said memory; and executing from said application said synchronization instruction with said retrieved at least one parameter (Alam, column 12, line 67 through column 13, line 17).

- <Claim 11>

The method of claim 1, wherein: said executing a synchronization instruction from said application further comprises executing said synchronization instruction in response to an event (Alam, column 10, lines 44-52).

- <Claim 12>

The method of claim 11, wherein: said event comprises selecting a button or icon displayed by said application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claim 13>

The method of claim 11, wherein: said event comprises selecting a menu item displayed by said application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claim 14>

The method of claim 11, wherein: said event comprises one of selecting a form and closing a form displayed on said personal data assistant (Alam, column 8, lines 9-14).

- <Claim 15>

A system comprising:

a personal data assistant comprising at least one first database (Alam, figure 1, items 12, 20, and 22); and

a host device adapted to be connected to said personal data assistant over a wireless connection and including at least one second database (Alam, figure 1, items 14, 32, and 34 and column 5, lines 36-52);

wherein said personal data assistant is adapted to be configured to execute a synchronization instruction, said synchronization instruction comprising a command for synchronizing said at least one first database and said at least one second database,

[Alam, column 10 «lines 25-43»] and comprising a command to pass control to a particular application after synchronization [Hawkins, column 8 «lines 11-15»].

- <Claim 16>

The system of claim 15, wherein said personal data assistant further comprises: a runtime engine executing said application (Alam, figure 1, item 24); and a memory storing a program file received from said host device, said program file including said synchronization instruction executed by said personal data assistant (Alam, column 4, line 43 through column 5, line 11 and column 8, lines 34-49).

- <Claim 17>

The system of claim 16, wherein: said runtime engine is configured to retrieve said synchronization instruction from said program file and execute said synchronization instruction (Alam, column 12, line 48 through column 13, line 17).

- <Claim 18>

The system of claim 17, wherein: a first synchronization process is launched on said personal data assistant and a second synchronization process is launched on said host device for synchronizing in response to said execution of said synchronization instruction (Alam, figure 6, items 140 and 148).

- <Claim 19>

The system of claim 17, wherein: said host device further comprises an integrated design environment configured to generate said application and said program file, said application and said program file being downloaded to said personal

data assistant from said host device through a communication link (Alam, column 5, lines 28-52).

- <Claim 20>

A data synchronization system comprising:

a host computer including an integrated design environment (Alam, figure 1, item 14), a first plurality of databases (Alam, figure 1, items 32 and 34), and at least one application (Alam, figure 1, item 30), wherein said host computer is configured to generate said at least one application and a program file including instructions executed with said application (Alam, column 5, lines 28-34); and

a personal data assistant connected to said host computer through a wireless connection (Alam, figure 1, item 12 and column 5, lines 36-52), said personal data assistant comprising a runtime engine (Alam, figure 1, item 24) and a second plurality of databases (Alam, figure 1, items 20 and 22);

wherein said personal data assistant is configured to receive said at least one application and program file from said host computer (Alam, column 5, lines 28-52), and said runtime engine is configured to initiate said at least one application and a synchronization instruction in said program file, said synchronization instruction comprising a command for synchronizing at least one database in said second plurality of databases with at least one associated database from said first plurality of databases (Alam, column 10, lines 53-62; column 12, lines 15-26; and column 13, lines 6-17), and a command to pass control to a particular application after synchronization [Hawkins, column 8 «lines 11-15»].

- <Claims 21, 26, and 27>

A method of synchronizing data between a personal data assistant and a remote computer, comprising:

selecting from said personal data assistant which files on said personal data assistant to synchronize with said remote computer (Alam, column 12, line 48 through column 13, line 5);

establishing wireless communications between said personal data assistant and said remote computer (Alam, column 10, lines 53-62; column 12, lines 15-26; and column 5, lines 36-52); and

running an application on said personal data assistant (Alam, Figure 1 «items 24, 16, 18» | Figure 6 «items 140, 144, 146»), said application comprising a synchronization instruction comprising a command for synchronizing information between said personal data assistant [Alam, column 10 «lines 25-43»] and a command to pass control to a particular application after synchronization [Hawkins, column 8 «lines 11-15»].

- <Claims 22 and 28>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, wherein: said synchronizing is performed over a wireless connection (Alam, column 5, lines 36-52).

- <Claims 23 and 29>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, wherein: said synchronizing synchronizes a

first database on said personal data assistant with a second database on said remote computer (Alam, column 10, lines 53-62).

- <Claims 24 and 30>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, further comprising: selecting a button or icon displayed by an application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claims 25 and 31>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, further comprising: selecting a menu item displayed by an application on said personal data assistant (Alam, column 9, lines 14-22).

Since the combination of Alam and Hawkins discloses all of the above limitations, claims 1-7 and 9-31 are rejected.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ainsworth et al, U.S Patent No. 5.319.774;

Veghte et al, U.S Patent No. 5.845.293;

Kaufman, U.S Patent No. 6.034.621;

Kruglikov et al, U.S Patent No. 6.205.448;

Application/Control Number:
09/977,686
Art Unit: 2152

Page 15

LaRue et al, U.S Patent No. 6.487.560;

Hertzog et al, U.S Patent Publication No. 2003|0069874;

Grambihler et al, U.S Patent No. 6.560.655;

McLlroy et al, U.S Patent No. 6.701.521.

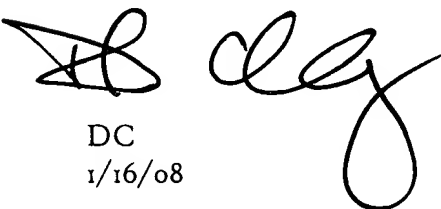
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC
1/16/08

Handwritten signature and initials in black ink. The signature is a stylized cursive 'D' followed by a long horizontal stroke. The initials are 'AB' and 'CJ'.